APPENDIX A — 35 U.S.C. § 305

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 or this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

(Dec. 12, 1980, Pub L. 96-517, § 1,94 Stat. 3016; Nov. 8, 1984, Pub. L. 98-622, § 204, 98 Stat. 3388.)

APPENDIX B — MISCELLANEOUS PTO ACTIONS IN U.S. PATENT APPLICATION SERIAL NUMBER 399,365 DECEMBER 1990 - OCTOBER 1991

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: Commissioner of Patents and Trademarks

Washington, D.C. 20231

05/399,365 00/00/00 *DVORAK, L*

ZARLEY, MC KEE, THOMTE,
VOORHEES & SEASE
STE 3200
801 GRAND AVE.
DES MOINES, IOWA 50309

332

12/21/90

☒ This application has been examined
☒ Responsive to communication filed on *8-17-90*

A shortened statutory period for response to this action is set to expire *three* month(s), ___ days from the date of this letter.

Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.

* * *

Part II SUMMARY OF ACTION

1. ☒ Claims *11-17* are pending in the application.

* * *

4. ☒ Claims *11-17* are rejected.

* * *

Appendix B

Serial No. 05/399365
Art Unit 332

✓ The use of the trademark VELCRO has been noted in this application. It should be capitalized in its entirety wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

✓ The disclosure is objected to because of the following informalities: Page 1, line 2, "shannel" should read - channel -. Appropriate correction is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless — (b) the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hill.

Hill discloses a drop foot brace with all of the features of the instant invention as broadly as claimed including an L-shaped member having a leg portion (20); a curved heel

portion (25) integral with one end of said leg portion, said heel portion being curved away from contact with the heel of the patient, said heel portion containing a flexing portion; a foot portion (21); and means for releasably securing said device to the leg and foot of a patient (6). Note Figure 3. Regarding claim 12, note that the "whereby" clause is simply a statement of intended use and is given limited patentable weight. Nevertheless, note that the device of Hill is capable of being "forcibly pivoted to an angle greater than a right angle . . ." as broadly as claimed.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Appendix B

Claims 11-14 and 17 are rejected under 35 U.S.C. § 103 as being unpatentable over Beacock in view of Domenico.

Beacock discloses a leg brace comprising an L-shaped member with leg (A), heel (A'), and foot (A2) portions; said heel portion containing a flexing portion, and wherein said heel portion is of a reduced cross sectional area; and an elongated strip of rigid material (A2) secured to said foot portion with one end of said strip extending upwardly beyond the normal position of the patient's toes. The only features of the instant invention Beacock fails to disclose are 1) the device being made of plastic; and 2) securing means. Domenico discloses a similar leg brace with securing means (note column 2, lines 54-58) and teaches his brace being made of plastic (note column 2, lines 60-61). It would have been obvious to one of ordinary skill in the art to make the device of Hill of plastic and with securing means in light of the teachings of Domenico.

Claims 11, 15, and 16 are rejected under 35 U.S.C. § 103 as being unpatentable over Peter in view of Domenico.

Peter discloses a leg brace comprising an L-shaped member with leg (22), heel, and foot (23) portions as well as securing means (34, 38). Peter further discloses elongated means (30) attached to said leg portion extending transversely therefrom to prevent lateral rotation of a patient's leg, as broadly as claimed. Peter still further discloses two foot and leg devices connected by an elongated spreader bar (30) to fixedly separate the legs and feet of a patient (note figure 1). As stated above, Domenico discloses a similar leg and foot device fabricated from plastic. It would have been obvious to one of ordinary skill in the art to use plastic as the material choice for the leg brace of Peter in light of the teachings of Domenico.

Appendix B

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Larson and Lee - Note the L-shaped plastic foot and leg members comprising a leg portion, a foot portion, and a heel portion as broadly as claimed in claim 1.

Phelps - Note the disclosed spreader and the prop means for preventing rotation of the leg.

Any inquiry concerning this communication should be directed to Linda C.M. Dvorak at telephone number (703) 308-0858.

s/ Linda C.M. Dvorak
Linda C.M. Dvorak
December 12, 1990

s/ Richard J. Apley
RICHARD J. APLEY
SPE
ART UNIT 332

Appendix B

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

05/399365

* * *

EXAMINER INTERVIEW SUMMARY RECORD

All participants (applicant's representative, PTO personnel):
(1) *Linda Dvorak (Exmr)*
(2) *Richard Apley (SPE)*
(3) *Donald Zarley (Atty)*

* * *

Date of interview *3/18/91*
Type: ☒ Personal (copy is given to ☒ applicant's representative).

Exhibit shown or demonstration conducted: ☒ No.

* * *

Agreement ☒ was not reached.

Claims discussed: *11, 17*

Identification of prior art discussed: *Hill, Beacock, Peter.*

Description of the general nature of what was agreed to if an agreement was reached, or any other comments: *Attorney*

Appendix B

argued that the prior art did not show a one-piece integral splint construction having curvature greater than curvature of the heel and have a flexibility at that point of curvature and large enough to sufficiently support the bottom of the patients foot. Examiner agreed to review prior art with these features in mind.

(A fuller description, if necessary, and a copy of the amendments, if available, which the wxaminer agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

Unless the paragraphs below have been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW (e.g., items 1-7 on the reverse side of this form). If a response to the last Office action has already been filed, then applicant is given one month from this interview date to provide a statement of the substance of the interview.

* * *

s/ Richard J. Apley
RICHARD J. APLEY
S.P.E

s/ Linda C.M. Dvorak
Examiner's Signature

Appendix B

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: Box ISSUE FEE
Commissioner of Patents and Trademarks
Washington, D.C. 20231

ZARLEY, MC KEE, THOMTE,
VOORHEES & SEASE
STE 3200
801 GRAND AVE.
DES MOINES, IOWA 50309

NOTICE OF ALLOWANCE AND ISSUE FEE DUE

* * *

SERIES CODE/SERIAL NO.: *05/399,365*
FILING DATE: *00/00/00*
TOTAL CLAIMS: *007*
EXAMINER AND GROUP ART UNIT: *DVORAK, L 332*
DATE MAILED: *05/21/91*

* * *

TITLE OF INVENTION
(AS AMENDED)
THERAPEUTIC LEG AND FOOT DEVICE

ATTY'S DOCKET NO.: *3*
CLASS-SUBCLASS: *128-080.000*
BATCH NO.: *P80*
APPLN. TYPE: *UTILITY*

Appendix B

SMALL ENTITY: *YES*
FEE DUE: *$525.00*
DATE DUE: *08/21/91*

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. *PROSECUTION ON THE MERITS IS CLOSED.*

THE ISSUE FEE MUST BE PAID WITHIN *THREE MONTHS* FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.

HOW TO RESPOND TO THIS NOTICE:

I. Review the SMALL ENTITY Status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the Status is changed, pay twice the amount of the FEE DUE shown above and notify the Patent and Trademark Office of the change in status, or

B. If the Status is the same, pay the FEE DUE shown above.

If the SMALL ENTITY is shown as NO:

A. Pay FEE DUE shown above, or

B. File verified statement of Small Entity Status before, or with, payment of 1/2 the FEE DUE shown above.

Appendix B

II. Part B of this notice should be completed and returned to the Patent and Trademark Office (PTO) with your ISSUE FEE. Even if the ISSUE FEE has already been paid by a charge to deposit account, Part B should be completed and returned. If you are charging the ISSUE FEE to your deposit account, PART C of this notice should also be completed and returned.

III. All communications regarding this application must give series code (or filing date), serial number and batch number. Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

Important Reminder: ***Patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees.***

Appendix B

PART B - ISSUE FEE TRANSMITTAL

MAILING INSTRUCTIONS: This form should be used for tansmitting the ISSUE FEE. Blocks 2 through 6 should be completed where appropriate. All further correspondence including the issue Fee Receipt, the Patent, advanced orders and notification of maintenance fees will be mailed to addressee entered in Block 1 unless you direct otherwise, by: (a) specifying a new correspondence address in Block 3 below; or (b) providing the PTO with a separate "FEE ADDRESS" for maintenance fee notifications with the payment of Issue Fee or thereafter. **See reverse for Certificate of Mailing.**

1. CORRESPONDENCE ADDRESS

ZARLEY, MCKEE, THOMTE,
VOORHEES & SEASE
STE 3200
801 GRAND AVE.
DES MOINES, IOWA 50309

* * *

SERIES CODE/SERIAL NO.: *05/399,365*
FILING DATE: *00/00/00*
TOTAL CLAIMS: *007*
EXAMINER AND GROUP ART UNIT: *DVORAK, L 332*
DATE MAILED: *05/21/91*

* * *

TITLE OF INVENTION:
(AS AMENDED)
THERAPEUTIC LEG AND FOOT DEVICE

Appendix B

ATTY'S DOCKET NO.: *3*
CLASS-SUBCLASS: *128-080.000*
BATCH NO.: *P80*
APPLN. TYPE: *UTILITY*
SMALL ENTITY: *YES*
FEE DUE: *$525.00*
DATE DUE: *08/21/91*

* * *

Appendix B

PART C - CHARGE TO DEPOSIT ACCOUNT

1. CORRESPONDENCE ADDRESS

ZARLEY, MCKEE, THOMTE,
VOORHEES & SEASE
STE 3200
801 GRAND AVE.
DES MOINES, IOWA 50309

SERIES CODE/SERIAL NO.: *05/399,365*
FILING DATE: *00/00/00*
TOTAL CLAIMS: *007*
EXAMINER AND GROUP ART UNIT: *DVORAK, L 332*
DATE MAILED: *05/21/91*

TITLE OF INVENTION:
(AS AMENDED)
THERAPEUTIC LEG AND FOOT DEVICE

ATTY'S DOCKET NO.: *3*
CLASS-SUBCLASS: *128-080.000*
BATCH NO.: *P80*
APPLN. TYPE: *UTILITY*
SMALL ENTITY: *YES*
FEE DUE: *$525.00*
DATE DUE: *08/21/91*

* * *

Appendix B

Serial No. 05/399365
Art Unit 332

An Examiner's Amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 C.F.R. § 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the Issue Fee.

In claim 14, delete "12" and insert therefore — 11 —.
In claim 17, delete "12" and insert therefore — 11 —.

Authorization for this Examiner's Amendment was given in a telephone interview with Donald Zarley on 10 May 1991.

The following is an Examiner's Statement of Reasons for Allowance:

Lee, Beacock, and Domenico are all representative of the state of the art in therapeutic leg and foot devices at the time of filing of the instant invention. The prior art cited disclose L-shaped members having lag and heel portions. The aforementioned devices of Lee, Beacock, and Domenico teach conformation of the brace to the natural contour of the body portion, i.e. the heel. Note Beacock line 28; Lee, abstract; Domenico column 2, line 65. The prior art devices fail to show, however, the heel portion having a curvature greater than the normal curvature of the heel. It would not have been obvious to one of ordinary skill in the art to provide a leg and foot device with a heel portion having a curvature greater than the normal curvature of the heel as there is no motivation or suggestion to do so in the prior art, nor would it have been obvious to modify the base references of Lee, Beacock, or

Domenico to have such a heel curvature as to do so would destroy the teachings within each reference.

Any comments considered necessary by applicant must be submitted no later than the payment of the Issue Fee and, to avoid processing delays, should preferably **accompany** the Issue Fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Grunert [Swiss No. 346649] - Note figures 8-9 and 15-17 showing a "flexing portion" at the point of curvature as claimed in the instant invention.

The other patents are cited as being of interest.

Any inquiry concerning this communication should be directed to Linda C.M. Dvorak at telephone number (703) 308-0858.

s/ Linda C.M. Dvorak
Linda C.M. Dvorak
May 13, 1991

s/ Richard J. Apley
RICHARD J. APLEY
S.P.E
ART UNIT 332

Appendix B

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

* * *

Paper Number: *29*

EXAMINER INTERVIEW SUMMARY RECORD

All participants (applicant, applicant's representative, PTO personnel):
(1) *Linda Dvorak (Exmr.)*
(2) *Donald Zarley (Atty)*

Date of interview *5/10/91.*

Type: ☒ Telephonic

Exhibit shown or demonstration conducted: ☒ No.

Agreement ☒ was reached with respect to some or all of the claims in question.

Claims discussed: *11, 12, 14, 17*

Identification of prior art discussed: *None*

Description of the general nature of what was agreed to if an agreement was reached, or any other comments: *The following changes will be made to correct improper dependencies on a canceled claim: In claim 14, delete "12" and insert therefor — 11 —. In claim 17, delete "12" and insert therefor — 11 —. See Exmr's Amdnt attached.*

Appendix B

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

Unless the paragraphs below have been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW (e.g., items 1-7 on the reverse side of this form). If a response to the last Office action has already been filed, then applicant is given one month from this interview date to provide a statement of the substance of the interview.

* * *

s/ Linda C.M. Dvorak
Examiner's Signature

Appendix B

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C., 20231

Paper No. 31

Zarley, McKee, Thomte, Voorhees
& Sease
801 Grand Ave.
Suite 3200
Des Moines, Iowa 50309

In re Application of:	)	
Robert Lonardo	)	WITHDRAWAL FROM
Serial No.: 399,365	)	ISSUE
Filed: September 21, 1973	)	
For: THERAPEUTIC LEG	)	
AND FOOT DEVICE	)	

NOTIFICATION OF WITHDRAWAL FROM ISSUE

The purpose of this communication is to inform you that the above-identified application is being withdrawn from issue pursuant to 37 CFR 1.313.

The application is being withdrawn to permit reopening of prosecution. The reasons therefor will be communicated to you by the examiner.

Appendix B

Patent and Trademark Office records reveal that the issue fee has not been paid. If the issue fee has been submitted, the applicant may request a refund or may request that the fee be credited to a deposit account. However, applicant may wait until the application is either again found allowable or held abandoned. If the application is allowed, upon receipt of a new Notice of Allowance and Issue Fee Due, applicant may request that the previously submitted issue fee be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due. If the application is abandoned, applicant may request either a refund or a credit to a deposit account.

The application is being forwarded to the examiner for action.

s/ John J. Love
John J. Love
Director, Group 330

JJL:nlw

cc: Office of Publications:
1. Patent Clerk, CPK-1-512
2. Supervisory Correspondence Clerk, CPK-1-512

Appendix B

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

05/399365

SERIAL NUMBER: *05/399,365*
FILING DATE: *00/00/00*
FIRST NAMED INVENTOR: *Lonardo*
EXAMINER: *DVORAK, L*
ART UNIT: *332*
PAPER NUMBER: *32*
DATE MAILED: *08/06/91*

ZARLEY, MC KEE, THOMTE,
VOORHEES & SEASE
STE 3200
801 GRAND AVE.
DES MOINES, IOWA 50309

☒ This application has been examined
☒ Responsive to communication mailed on *7-15-91*

A shortened statutory period for response to this action is set to expire *three* month(s), ___ days from the date of this letter.

Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.

* * *

6. ☒ *Interview Summary from 3/18/91*

Appendix B

Part II SUMMARY OF ACTION

1. ☒ Claims *11, 13-18* are pending in the application.

* * *

4. ☒ Claims *11, 13-18* are rejected.

* * *

Appendix B

Serial No. 05/399365
Art Unit 332

Claims 11 and 13-18 are pending in the application.

The indicated allowability of claims 11 and 13-18 is withdrawn in view of the newly discovered prior art to Noble. The delay in citation of this art is regretted. Rejections based on the newly discovered prior art follow.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Appendix B

Claims 11, 13-15, and 17-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Noble in view of Beacock or Grunert [Swiss No. 346649].

Regarding claims 11, 17, and 18, Noble discloses a therapeutic leg and foot device comprising an L-shaped member [1] comprised of a one-piece integral flexible material [column 2, lines 52-54]; said L-shaped member having leg portion [8], a curved heel portion [9] integral with one end of said leg portion, and a foot portion [7] extending integrally from said heel portion at right angles to said leg portion; said heel portion having a curvature greater than the normal curvature of the heel of a patient wearing the device to provide a space between the patient's heel and said heel portion to prevent the application of pressure to the patient's heel by the heel portion [note 10; column 2, lines 23-26]; and means for releasably securing said device to the leg and foot of a patient [18]. The only feature of the instant invention as claimed not shown by Noble is that of a flexing portion at the curvature of the heel portion whereby the foot portion can be forcibly pivoted to an angle greater than a right angle. Beacock [figure 1] and Grunert [figures 8, 9, and 15-17] show the well known use of areas of reduced cross section on a splint positioned near the joint of the wearer in order to allow for flexing and extension of the joint. It would have been obvious to one of ordinary skill in the art to provide a flexing portion to the device of Noble in light of the teaching of Beacock and Grunert.

Regarding claims 13 and 14, note figures 1 and 2 and column 2, line 6 of Noble.

Regarding claim 15, note 13 of Noble.

Appendix B

Claim 16 is rejected under 35 U.S,C. § 103 as being unpatentable over Noble in view of Beacock or Grunert as applied to claim 11 above, and further in view of Peter.

Peter discloses the well known use of spreader bars in the art of foot supports as a means for fixedly separating the legs and feet of a patient by attaching the bar to two foot devices. It would have been obvious to one of ordinary skill in the art to use a spreader bar with the device of Noble as taught by Peter.

Any inquiry concerning this communication should be directed to Linda C.M. Dvorak at telephone number (703) 308-0858.

s/ Linda C.M Dvorak
Linda C.M Dvorak
July 25, 1991

s/ Richard J. Apley
RICHARD J. APLEY
SPE
ART UNIT 332

Appendix B

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

05/399365

SERIAL NUMBER: *05/399,365*
FILING DATE: *00/00/00*
EXAMINER: *DVORAK, L*
ART UNIT: *332*
PAPER NUMBER: *33*
DATE MAILED: *08/23/91*

ZARLEY, MC KEE, THOMTE,
VOORHEES & SEASE
STE 3200
801 GRAND AVE.
DES MOINES, IOWA 50309

EXAMINER INTERVIEW SUMMARY RECORD

All participants (applicant's representative, PTO personnel):
(1) *Linda Dvorak (Exmr)*
(2) *Richard Apley (SPE)*
(3) *Donald Zarley (Atty)*

Date of interview *8/22/91.*

Type: ☒ Personal (copy is given to ☒ applicant's representative).

Exhibit shown or demonstration conducted: ☒ No.

Appendix B

Agreement ☒ was not reached.

Claims discussed: *11,18*

Identification of prior art discussed: *Noble*

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:
See attached explanation.

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

Unless the paragraphs below have been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW (e.g., items 1-7 on the reverse side of this form). If a response to the last Office action has already been filed, then applicant is given one month from this interview date to provide a statement of the substance of the interview.

* * *

s/ Linda C.M. Dvorak
Examiner's Signature

s/ Richard J. Apley
RICHARD J. APLEY
SPE

Appendix B

Serial No. 05/399365
Art Unit 332

Applicant argued that Noble fails to show a "heel portion having a curvature greater than the normal curvature of the heel of a patient." Applicant contended that the heel of the brace in Noble has the same curvature as the curvature of the heel of the patient and that the gap 10 is only created by the patient's leg being supported on pad 11. Examiner disagreed and stated that Noble teaches of a "backwardly extending recess 10" and that the pad 11 is merely an optional accessory irrespective of the gap (column 2, lines 22-30).

s/ Richard J. Apley
RICHARD J. APLEY
SPE
ART UNIT 332
8-22-91

Appendix B

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

05/399365

SERIAL NUMBER: *05/399,365*
FILING DATE: *00/00/00*
EXAMINER: *DVORAK, L*
ART UNIT: *332*
PAPER NUMBER: *35*
DATE MAILED: *10/10/91*

ZARLEY, MC KEE, THOMTE,
VOORHEES & SEASE
STE 3200
801 GRAND AVE.
DES MOINES, IOWA 50309

☒ This application has been examined
☒ Responsive to communication mailed on *9-3-91* ☒ This action is made final.

A shortened statutory period for response to this action is set to expire *three* month(s), ___ days from the date of this letter.

Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133.

* * *

Appendix B

Part II SUMMARY OF ACTION

1. ☒ Claims *11, 13-18* are pending in the application.

* * *

4. ☒ Claims *11, 13-18* are rejected.

* * *

Appendix B

Serial No. 05/399365
Art Unit 332

Claims 11 and 13-18 are pending in the application.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 11, 13-15, and 17-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Noble in view of Beacock or Grunert [Swiss No. 346649].

Appendix B

Regarding claims 11, 17, and 18, Noble discloses a therapeutic leg and foot device comprising an L-shaped member [1] comprised of a one-piece integral flexible material [column 2, lines 52-54]; said L-shaped member having leg portion [8], a curved heel portion [9] integral with one end of said leg portion, and a foot portion [7] extending integrally from said heel portion at right angles to said leg portion; said heel portion having a curvature greater than the normal curvature of the heel of a patient wearing the device to provide a space between the patient's heel and said heel portion to prevent the application of pressure to the patient's heel by the heel portion [note 10; column 2, lines 23-26]; and means for releasably securing said device to the leg and foot of a patient [18]. The only feature of the instant invention as claimed not shown by Noble is that of a flexing portion at the curvature of the heel portion whereby the foot portion can be forcibly pivoted to an angle greater than a right angle. Beacock [figure 1] and Grunert [figures 8, 9, and 15-17] show the well known use of areas of reduced cross section on a splint positioned near the joint of the wearer in order to allow for flexing and extension of the joint. It would have been obvious to one of ordinary skill in the art to provide a flexing portion to the device of Noble in light of the teaching of Beacock and Grunert.

Regarding claims 13 and 14, note figures 1 and 2 and column 2, line 6 of Noble.

Regarding claim 15, note 13 of Noble.

Claim 16 is rejected under 35 U.S.C. § 103 as being unpatentable over Noble in view of Beacock or Grunert as applied to claim 11 above, and further in view of Peter.

Appendix B

Peter discloses the well known use of spreader bars in the art of foot supports as a means for fixedly separating the legs and feet of a patient by attaching the bar to two foot devices. It would have been obvious to one of ordinary skill in the art to use a spreader bar with the device of Noble as taught by Peter.

Applicant's arguments filed 9/3/91 have been fully considered but they are not deemed to be persuasive.

Applicant's argues that the shape of the Noble splint heel portion is of the same curvature as that of the patient's heel and that Noble does not show or teach "said heel portion having a curvature greater than the normal curvature of the heel of a patient wearing the device to provide a *space* between the patient's heel and said heel portion". Applicant submits an enlarged reproduction of figure 2 of Noble with a transparent overlay which presents this argument. Applicant further argues that Noble teaches only a *space* between the heel and the splint; the only means or structure that Noble shows or teaches to create this space 10 is the use of pad 11, and if Noble does teach the use of space 10 by some means other than pad 11, Noble does not disclose what other structure Noble employs to create the space.

The examiner disagrees and fails to see any patentable distinction between the space of Noble and the space of the instant invention. Firstly, the enlargement of figure 2 and the transparent overlay are noted. However, the examiner contends that the positioning of the overlay on figure 2 does not clearly represent "the curvature of the heel of a patient wearing the device" as the foot of the patient in the overlay is not at all properly positioned in the device; note the overhang of the foot at portion 7. If the patient in the overlay were allowed to

flex his/her foot to insure the patient was wearing the device, the curvature of the heel of the patient would retract and be more realistically positioned as shown in the original figure 2 of Noble.

Notwithstanding what the applicant believes to be *visualized* in the Noble patent, surely one cannot argue with the written teaching of Noble. Noble states (column 2, lines 21+): "the two portions 7 and 8 of the guard are generally at right angles to each other and are joined by the heel portion 9 which has a backwardly extending recess 10 that frees the heel from contact with the guard . . ." Noble continues (column 2, line 30): "If desired, a pad . . . 11 may be provided." Clearly by the use of the phrase "if desired" Noble intended for pad 11 to be an optional accessory not necessary for, and having nothing to do with, the creation of backwardly extending recess 10. Therefore, the space must be created by the structure of portions 7, 8, and 9.

Thus, if the guard of Noble is shaped to generally fit the foot of the user (column 2, lines 14+), and Noble teaches of a backwardly extending recess 10, and it has been shown that pad 11 is in no way responsible for the creation of such a recess, then clearly the guard of Noble must possess the claimed limitation of the instant invention, namely, a heel portion having a curvature greater than the normal curvature of the heel of a patient wearing the device in order for such a recess to exist.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

Appendix B

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILE WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Linda C.M. Dvorak at telephone number (703) 308-0858.

s/ Linda C.M. Dvorak
Linda C.M. Dvorak
October 8, 1991

s/ Richard J. Apley
RICHARD J. APLEY
SPE
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